

### **REMARKS**

The Final Office Action of May 26, 2006 has been carefully reviewed and these remarks are responsive thereto. Claims 1-2, 4-15, 17-22, and 24-39 are pending. Claims 3, 16 and 23 are cancelled. Claims 1-2, 4-15, 17-22, and 24-39 stand rejected. Claims 1, 2, 4-6, 10-15, 24-26 and 30-32 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,662,691 to Behan *et al.* (Behan). Claims 17-21 and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Behan. Claims 7-9 and 27-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Behan in view of U.S. Patent No. 6,580,948 to Hauptert *et al.* (Hauptert). Claims 22 and 33-38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Behan in view of U.S. Patent No. 6,738,670 to Almendinger *et al.* (Almendinger).

#### **Claim Rejections Under 35 USC §102(b) - Behan**

Claims 1, 2, 4-6, 10-15, 24-26 and 30-32 were rejected under 35 USC §102(b) as being unpatentable over Behan. Claims 1, 2 and 13 are independent.

Looking at claim 1, as an initial matter, the Office Action mailed on December 22, 2005 on page 3 has already admitted that Behan does not disclose the bi-directional communication between an external stimulator and a programmer, stating “[h]owever, the use of bidirectional communication between the external stimulator and the programmer is not fully set forth in the disclosure of the patent.” Therefore, for this reason alone Behan cannot be said to disclose all the features of claim 1.

In addition, claim 1 recites the feature “wherein the programmer is configured to provide to the external neural stimulator configuration information for a type of an implantable neural stimulator that is to be implanted.” The Office Action suggested that this feature was considered analogous to the mode and operating parameters set forth in Behan. Contrary to the Office Action’s suggestion, Applicants respectfully submit that the mode and operating parameters disclosed by Behan cannot be considered analogous to the “external neural stimulator configuration information for a type of an implantable neural stimulator that is to be implanted” recited in claim 1. The mode and operating parameters relate to how the external device is programmed (See Behan, Col. 5, Ln. 30-41). In contrast, the “external neural stimulator configuration information for a type of implantable neural stimulator” relates to the type of implantable device that will be implanted. These are distinct concepts. Furthermore, as Behan discloses that the external component that emulates the implantable defibrillator has essentially

identical circuitry as the implantable defibrillator, see Behan, Col. 5, Ln. 55 – Col.6, Ln. 13, there would be no reason to provide such information for the system of Behan. Thus, the Office Action has at most provided support for the suggestion that Behan discloses providing instructions for operating the external device but has failed to provide support for the above referenced feature of claim 1.

The Office Action further suggested that the structure of Behan is capable of transmitting such information. Applicants respectfully submit that this argument fails to address whether the feature recited in claim 1 is disclosed by Behan. In order for a reference to properly be considered anticipatory and to support a 35 U.S.C. § 102 rejection, every feature of the claim at issue must be present in the cited reference, either expressly or inherently. Thus, assuming for the purpose of this response that the system of Behan was capable of provide such information, such an argument does not support the rejection because it fails to address the issue of whether Behan actually discloses the recited feature. In other words, merely being capable of doing something is insufficient to support an inherency argument and being capable of doing something plainly fails to support an express disclosure argument.

Accordingly, for at least the above reasons Behan fails to disclose all the features of claim 1 and therefore claim 1 cannot be considered anticipated by Behan.

Claims 4-6 and 10-12 depend from claim 1 and are not anticipated for at least the above reasons and for the additional features recited therein.

Independent claim 2 recites features similar to the features discussed above with respect to claim 1 and therefore cannot be said to be anticipated by Behan for at least the above reasons and for the additional features recited therein.

Claims 24-26 and 30-32 depend from claim 2 and are not anticipated by Behan for at least the reasons that claim 2 is not anticipated and for the additional features recited therein.

Independent claim 13 recites features similar to the features discussed with respect to claim 1 and therefore cannot be said to be anticipated by Behan for at least the above reasons that claim 1 is not anticipated and for the additional limitations recited therein.

Claims 14-15 depend from claim 13 and are not anticipated by Behan for at least the reasons that claim 13 is not anticipated and for the additional features recited therein.

Accordingly, withdrawal of this ground of rejection is respectfully requested.

**Claim Rejections Under 35 USC §103 – Behan**

Claims 17-21 and 39 were rejected under 35 USC §103(a) as being unpatentable over Behan. Claim 17 is independent.

As an initial matter, as noted above, the Office Action mailed on December 22, 2005 on page 3 has already admitted that Behan does not disclose the bi-directional communication between an external stimulator and a programmer, stating “[h]owever, the use of bidirectional communication between the external stimulator and the programmer is not fully set forth in the disclosure of the patent.” Therefore, for this reason alone Behan cannot be said to disclose, suggest or teach all the features of claim 1.

In addition, independent claim 17 recites the step of “providing configuration information for a type of implantable neural stimulator that is to be programmed.” Applicants have reviewed Behan and have been unable to locate any mention of such a step. Nor has the Office Action suggested that Behan actually discloses this step. Instead, the Office Action suggests that such a step would obviously follow from the normal working of Behan, apparently suggesting that such a step is inherently found in Behan. As this suggestion is made in the context of an obviousness rejection, Applicants assume that the Office Action is merely suggesting that the particular step is inherent in the operation of Behan. Applicants note that for a feature to be inherently present, that feature necessarily must be present.

Turning to Behan, it is plain that recited step is not inherent in the operation of Behan. First, Behan makes no mention of such a step. Second, Behan has no need of such a step because there is no need for the device of Behan to provide configuration information of a type of implantable neural stimulator in the first place. This is because Behan discloses using the same circuitry in the external device as the implantable defibrillator and simply does not contemplate the concept of providing configuration information. (See Behan, Col. 5, Ln. 55 – Col.6, Ln. 13). Therefore, providing such information would be unhelpful in the system disclosed by Behan and the normal working of Behan would not be to provide such information. In other words, the concept of providing information on the type of implantable neural stimulator that is to be programmed is simply foreign to Behan because Behan addresses the issue in a different manner. Therefore, Behan fails to disclose, suggest or teach the above recited feature of claims 17 for at least this additional reason.

Accordingly, for at least the above reasons, Behan fails to disclose, suggest or teach all the features of claim 17. As Behan fails to disclose or suggest all the features of claim 17, Behan cannot be said to support a *prima facie* cause of obviousness with respect to claim 17. See MPEP 706.02(j) (“To establish a *prima facie* case of obviousness, three basic criteria must be met. ... [Third], the prior art reference[s] ... must teach or suggest all the claim limitations.”).

Claims 18-21 and 39 depend from claim 17 and are nonobvious in view of Behan for at least the above reasons discussed with respect to claim 17 and for the additional features recited therein. For example, claim 39 recites “establishing a first RF leg of the bi-direction communication link between the programmer and a remote telemetry unit” and “establishing a second RF leg of the bi-directional communication link between the remote telemetry unit and the external neural stimulator” and the Office Action has failed to point to any place in Behan that disclose these recited steps.

#### **Claim Rejections Under 35 USC §103 – Behan & Hauptert**

Claims 7-9 and 27-29 were rejected under 35 USC §103(a) as being unpatentable over Behan in view of Hauptert. Claims 7-9 depend from independent claim 1 and claims 27-29 depend from claim 2. The Office Actions suggests that, as disclosed in prior office actions, it would be obvious to use Hauptert as previously discussed with the device of Behan. As noted above, Behan fails to disclose all the features of independent claims 1 and 2, from which the rejected claims depend. The Office Action did not suggest that Hauptert remedies the above mentioned deficiencies in Behan. Nor did the prior office actions make such a suggestion. Nor are Applicants aware of any disclosure in Hauptert that may be argued to correct the above noted deficiency in Behan. Therefore, for at least the reasons discussed above with respect to the independent claims 1 and 2, Behan fails to disclose, suggest or teach all the features of claims 7-9 and 27-29. Thus, claims 7-9 and 27-29 are nonobvious in view of the combination of Behan and Hauptert.

Accordingly, withdrawal of this ground of rejection is respectfully requested.

#### **Claim Rejections Under 35 USC §103 – Behan & Almendinger**

Claims 22 and 33-38 were rejected under 35 U.S.C. § 103(a) in view of Behan and Almendinger. Claim 22 is independent.

The Office Action suggested that the rationale provided in the prior office actions supported this rejection. Applicants initially note that the prior office actions suggested that these claims were obvious in view of the combination Hauptert, Behan and Almendinger. Therefore, no support has been provided for the current rejection of Behan and Almendinger without Hauptert, either in the Office Action or in the past office actions. Furthermore, in view of the remarks provided in the previous office action that admitted that Behan was deficient because “the use of bidirectional communication between the external stimulator and the programmer is not fully set forth in the disclosure of the patent,” (Office Action mailed on December 22, 2005, pg. 3), this rejection appears to be improper.

In addition, independent claim 22 was previously amended to recite “wherein the physician programmer is further configured to provide to the external neural stimulator configuration information for a type of the implantable neural stimulator that is to be implanted.” As noted above with respect to claim 1, Behan fails to disclose this feature. Applicants are unaware of any disclosure in Almendinger that corrects the above noted deficiencies in Behan. Nor has the Office Action suggested that Almendinger can correct the above noted deficiencies in Behan. Accordingly, for at least the reasons discussed above with respect to this feature in claim 1, claim 22 is nonobvious in view of the combination of Behan and Almendinger.

Claims 33-38 depend from claim 22 and are non-obvious for at least the reasons discussed above with respect to claim 22 and for the additional features recited therein.

Accordingly, withdrawal of this ground of rejection is respectfully requested.

**CONCLUSION**

Applicants therefore respectfully request reconsideration of the pending claims and a finding of their allowability. A notice to this effect is respectfully requested. Please feel free to contact the undersigned should any questions arise with respect to this case that may be addressed by telephone.

Respectfully submitted,

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